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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/810,186	03/19/2001	Chieko Ohsumi	204934US0	6978
22850	7590	09/22/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			COLLINS, CYNTHIA E	
			ART UNIT	PAPER NUMBER
			1638	

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/810,186

Applicant(s)

OHSUMI ET AL.

Examiner

Cynthia Collins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2005 and 06 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application July 6, 2005 after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 29, 2005 has been entered.

Claims 1-27 are cancelled.

Claims 48-54 are newly added.

Claims 28, 33, 38 and 43 are currently amended.

Claims 28-47 are newly added.

Claims 28-54 are pending and are examined.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

All previous objections and rejections not set forth below have been withdrawn.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 28-47 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not

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described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection. Claims 28 and 33 require “growing plants under drought conditions”; “growing plants under drought conditions” as a means of increasing the drought resistance of plants does not find support in the specification as originally filed and thus constitutes new matter. Claims 38 and 43 require “growing plants under high salt conditions”; “growing plants under high salt conditions” as a means of increasing the resistance of plants to high salt concentration does not find support in the specification as originally filed and thus constitutes new matter. In this regard it is noted that Examples 2 and 3 indicate that the method requires the active step of selecting transformed plants having raffinose synthetic activity of at least 4.7 nmol/hr/mg, i.e. at least 4.7 fold greater than that of a wild type plant grown under the same conditions (Table 1 page 24).

Claim Rejections - 35 USC § 102

Claims 48-54 are rejected under 35 U.S.C. 102(a) as being anticipated by EP 0 994 186 A1 (AJINOMOTO CO. INC., 19.04.2000), for the reasons of record.

Applicant's arguments filed April 29, 2005 have been fully considered but they are not persuasive.

Applicant maintains that EP 0 994 186 A1 does not anticipate the rejected claims because the plant produced in that reference does not have an increased raffinose synthase activity compared to the plant before introducing the gene. (reply page 9).

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The Examiner maintains that while EP 0 994 186 A1 is silent with respect to the raffinose synthase activity of the transgenic plants exemplified therein, the transgenic plants exemplified therein are presumed to inherently have an increased raffinose synthase activity compared to the plant before introducing the gene, as the transgenic plants exemplified therein comprise the raffinose synthetase coding sequence under the control of a CaMV 35S promoter and nopaline synthase terminator (page 21), regulatory sequences that are known in the art and also exemplified in the instant specification as being functional in plant cells.

Claims 48-54 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 0 849 359 A2 (SUMITOMO CHEMICAL CO, 24.06.1998), for the reasons of record.

Applicant's arguments filed April 29, 2005 have been fully considered but they are not persuasive.

Applicant maintains that EP 0 849 359 A2 does not anticipate the rejected claims because, according to page 19 lines 26-41 of the reference, it was not confirmed whether the plant described in the reference expresses the raffinose synthase gene, or has a higher raffinose synthase activity as claimed (reply page 10).

The Examiner maintains that while EP 0 849 359 A2 is silent with respect to expression of raffinose synthase in the transgenic plants exemplified therein, the transgenic plants exemplified therein are presumed to inherently express raffinose synthase, as the transgenic plants exemplified therein comprise the raffinose synthetase coding sequence under the control of a CaMV 35S promoter and nopaline synthase terminator (page 18), regulatory sequences that

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are known in the art and also exemplified in the instant specification as being functional in plant cells.

Claims 48-54 are rejected under 35 U.S.C. 102(b) as being anticipated by JP411123080-A (AJINOMOTO CO. INC., May 11, 1999), for the reasons of record.

Applicant's arguments filed April 29, 2005 have been fully considered but they are not persuasive.

Applicant maintains that JP411123080-A does not anticipate the rejected claims because the plant produced in that reference does not have an increased raffinose synthase activity compared to the plant before introducing the gene. (reply page 9).

The Examiner maintains that while JP411123080-A is silent with respect to the raffinose synthase activity of the transgenic plants exemplified therein, the transgenic plants exemplified therein are presumed to inherently have an increased raffinose synthase activity compared to the plant before introducing the gene, as the transgenic plants exemplified therein comprise the raffinose synthetase coding sequence under the control of a CaMV 35S promoter and nopalinsynthetase terminator (English translation page 38), regulatory sequences that are known in the art and also exemplified in the instant specification as being functional in plant cells.

Remarks

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Collins whose telephone number is (571) 272-0794. The examiner can normally be reached on Monday-Friday 8:45 AM -5:15 PM.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones can be reached on (571) 272-0745. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Cynthia Collins
Primary Examiner
Art Unit 1638

CC


9/15/05